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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,325	05/18/2005	David A. Cheresh	TSRI 651.6	5729

2387 7590 10/16/2007

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EXAMINER	
PROUTY, REBECCA E	
ART UNIT	**PAPER NUMBER**
1652	

MAIL DATE	DELIVERY MODE
10/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/535,325	CHERESH ET AL.	
	Examiner	Art Unit	
	Rebecca E. Prouty	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 August 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28,34 and 35* is/are pending in the application.

4a) Of the above claim(s) *7-9,14-20 and 28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6, 10-13, 21-27, 34, and 35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claims 29-33 are cancelled. Claims 1-28 and 34-35 are at issue and are present for examination.

Applicant's election without traverse of Group I, and the species AGL 1872 (PP1) in the response filed 8/2/07 is acknowledged.

Claims 7-9, 14-20 and 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the response filed 8/2/07.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 10-11, and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Feng et al. (US Patent 5,731,343).

Feng et al. teach methods of treating diseases including myocardial infarction using with the compound radicicol (see column 2, lines 37-41 and column 3, lines 54-60). Radicicol is disclosed as an inhibitor of the tyrosine kinase Src (see example 2). Feng et al. further teach that radicicol can be administered by intraperitoneal injection, intravenous injection, orally or parentally (see column 7, lines 34-40). Thus Feng et al. anticipate all of the instant claims.

Claims 1-4, 11, and 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Das et al. (US Patent Application 2002/0123484).

Das et al. teach methods of treating diseases including myocardial infarction using tyrosine kinase inhibitors (see paragraph [0164]). These compounds are disclosed as inhibitors of tyrosine kinases including Src kinases (see paragraph [0161]). Das et al. further teach that these compounds can be administered by intravenous injection, orally or parentally (see paragraph [0170]). Thus Das et al. anticipate all of the instant claims.

Claims 1-4, 11, and 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Barrish et al. (US Patent 6,235,740).

Barrish et al. teach methods of treating diseases including myocardial infarction using tyrosine kinase inhibitors (see column 17, line 66 - column 18, line 6). These compounds are disclosed as inhibitors of tyrosine kinases including Src kinases (see column 17, lines 34-36). Barrish et al. further teach that these compounds can be administered by intravenous injection, orally or parentally (see column 19, lines 33-38). Thus Barrish et al. anticipate all of the instant claims.

Claims 1-6, 10-13, 21-23, 26-27, 34, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Losordo (US Patent Application 2006/0167021).

Losordo teach methods of treating diseases including myocardial infarction using with the compound PP1 (see paragraph [0003] and paragraph [0056]). PP1 is disclosed as an inhibitor of the tyrosine kinase Src (see paragraph [0056]). Losordo further teach that PP1 can be administered by intraperitoneal injection or intravenous injection (see paragraph [0059])at 15 minutes to 6 hours following the myocardial infaction (see Examples 3 and 4). Thus Losordo. anticipate all of the instant claims. While the effective filing date of Losordo (10/4/02) falls after some of the claimed priority dates of the instant application, none of applications 09/538,248, 09/470,881,

PCT/US99/11780 or 60/087,220 teach the use of small organic chemical inhibitors of Src family tyrosine kinases for treatment of myocardial infarction As such the instant claims have not been granted the benefit of the filing date of the prior applications.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-3, 5, 6, 10-13, 21-25. and 27 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-5, 13-16, 30-34, and 36 of copending Application No. 10/801,050. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. The claims of the instant application and those of the copending application are identical.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 10-13, 21-27, 34, and 35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-11, 19, 20, and 23-25 of copending Application No. 10/298,377. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or

would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-6, 10-13, 21-27, 34, and 35 are generic to all that is recited in claims 7-11, 19, 20, and 23-25 of copending Application No. 10/298,377. Both the claims in the instant application and that of the copending application recite methods of treating or preventing myocardial infarction by administering a Src kinase inhibitor, and preferably PP1. Claims 7-11, 19, 20, and 23-25 of copending Application No. 10/298,377 fall entirely within the scope of claims 1-6, 10-13, 21-27, 34, and 35 or, in other words, claims 1-6, 10-13, 21-27, 34, and 35 are anticipated by claims 7-11, 19, 20, and 23-25 of copending Application No. 10/298,377.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 4, 26, 34 and 35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 30-36 of copending

Application No. 10/801,050. Although the conflicting claims are not identical, they are not patentably distinct from each other. Both the claims in the instant application and that of the copending application recite methods of treating or preventing myocardial infarction by administering a Src kinase inhibitor, and preferably PP1. The claims differ in the scope of Src kinase inhibitor. Claims 4, 26, 34 and 35 cannot be considered patentably distinct over claims 1-5 and 30-36 of copending Application No. 10/801,050 when there is a specifically recited embodiment i.e., PP1 that would anticipate claims 4, 26, 34 and 35. Alternatively, claims 4, 26, 34 and 35 cannot be considered patentably distinct over claims 1-5 and 30-36 of copending Application No. 10/801,050 when there is a specifically disclosed embodiment in the copending application that supports claims 1-5 and 30-36 of copending Application No. 10/801,050 falls within the scope of claims 4, 26, 34 and 35 herein because it would have been obvious to one having ordinary skill in the art to modify the method of claims 4, 26, 34 and 35 by selecting a specifically disclosed embodiment that supports that claim, i.e., PP1. One having ordinary skill in the art would have been motivated to do this because that embodiment is disclosed as being a preferred embodiment within claims 4, 26, 34 and 35.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca E. Prouty whose telephone number is 571-272-0937. The examiner can normally be reached on Tuesday-Friday from 8 AM to 5 PM. The examiner can also be reached on alternate Mondays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (571) 272-0928. The fax phone number for this Group is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rebecca Prouty/
Primary Examiner
Art Unit 1652